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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/327,107 06/07/99 LANG

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EXAMINER

TM02/0605

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ART UNIT

PAPER NUMBER

2162

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicati n No.

09/327,107

Applicant(s)

LANG, BROOK

Examiner

Khanh H. Le

Art Unit

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-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☒ The ~~proposed drawing correction~~ ^{FORMAL DRAWINGS} filed on 7/22/00 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: .

NON-FINAL ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-2, 5-6, 8-11, 14-15, 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hidary, US 5822775, hereinafter “Hidary”.

Claim 1.

Hidary, disclosed a advertising system.

A method of marketing to users of an electronic device connected via a wireless connection to a wide area network (cellular telephone network) comprising the following steps:

a. identifying an electronic device connected to a wide area network (Fig 1, items 22 and 26; fig 2 , item 52; and their associated text)

b. determining the physical location of said electronic device (cell ID) when connected to said wide area network ((, Fig 1; fig 2 , item 54 and associated text)

c. creating a user file containing the identity and physical location information of said electronic device (see above, inherent in the system)

d. selecting advertising material to be sent to said electronic device; (Figs 1 and 2, ,item 26, and associated text; see cols. 3 and 4; fig 4 and associated text) and

e. transmitting said advertising material to said electronic device over said wide area network using the identity and physical location information in said user file. (Figs 1 and 2, item 26, and associated text; see cols. 3 and 4; fig 4 and associated text)

As for claims 2-9, the method of claim 1 is as above-disclosed.

Claim 2. Hidary discloses wherein step (b) is carried out using location information transmitted by said electronic device when connected to said network. (abstract: “when communication ... established”)

Claim 5. Hidary further discloses a server connected to said wide area network, said server capable of receiving said identity and physical location information to create said user file. (fig 2 item 24 and associated text)

Claim 6. Hidary further discloses an additional step between steps (c) and (d) of determining the network connection activities of said electronic device when connected to said wide area network, said network connection activities being added to said user file. (the Hidary system monitors the user activities to see if it's an emergency call, if not ads are sent. Also, ads may also be sent to nonsubscribers depending on those activities: see Fig 3 and 4 and accompanying text. It is inherent in the Hidary system that all this data concerning the user is added to the user file).

Claim 8. Hidary further discloses the step of identifying the user of said electronic device (Fig 2 item 52 and related text).

As for claim 9, the method of claim 8 is as above-disclosed. Hidary further discloses said user file contains user identification information and is used to transmit advertising to said electronic device (Fig 3 and 4 and associated text).

Claim 10. A method of localized network marketing, comprising the following steps:

- a. identifying an electronic device having means to make a wireless connection to a wide area network;
- b. identifying a user of said electronic device;
- c. determining the physical location of said electronic device when connected to said wide area network;
- d. determining the network connection activities of said electronic device;
- e. creating a user file containing information of the identity of said electronic device, and the physical location of said electronic device when connected to the network;
- f. selecting advertising material; and g. transmitting said advertising material over said wide area network using the identity and physical location information in said user file.

Claim 10 essentially is a combination of claims 1, 6 and 8. Hidary discloses all the limitations of those claims (see above)

As for claims 11-19, the method of claim 10 is as above-disclosed.

Claim 11. (claim 11 is a combination of claims 10 and 5)
Hidary further discloses a server connected to said wide area network, said server capable of receiving said identity and physical location information to create said user file. (fig 2 item 24 and associated text)

As for claims 14-19, the method of claim 11 is as above-disclosed.

Claim 14. Hidary discloses that said step (c) is carried out by a cellular telephone system capable of determining the physical location of a cellular telephone used to connect to said wide area network. (fig 2 item 54 and related text)

Claim 15. Hidary further discloses the server is also the network service provider that provides said electronic device access to said wide area network (Hidary, col 2 l. 28 et

seq.:”Also associated with central station 12 is an ad server 24 used to manage commercial advertisement ...”

As for claims 18-19, the method of claim 15 is as above-disclosed.

Claim 18. Hidary further discloses said server collects said Network connection activities information and adds it to said user file. (the Hidary system monitors the user activities to see if it’s an emergency call, if not ads are sent. Also, ads may also be sent to nonsubscribers depending on those activities: see Fig 3 and 4 and accompanying text. It is inherent in the Hidary system that all this data concerning the user is added to the user file).

Claim 19. wherein said server collects persona data of said user of said electronic device and adds it to said user file. (fig 2 item 58 and related text, esp. col 3 118-23)

Claim 20. A method of localized network marketing, comprising the following steps: a. identifying an electronic device having means to make a wireless connection to a wide area network; b. identifying the user of said electronic device; c. determining the physical location of said electronic device when connected to said wide area network; d. determining the network connection activities of said electronic device; e. creating a user file containing information of the identity of said electronic device, the identity of said user and the physical location of said electronic device when connected to the network; f. selecting advertising material to be sent to the user; and g. transmitting said advertising material to said user over said wide area network using the electronic device identity, user identity and physical location information in said user file.

Claim 20 essentially parallels Claim 10 except for the use of the identity of the user (step e), select ads for the user (step f) and transmitting using the user ID (step g) . Hidary discloses all such steps as discussed above.

As for claims 21-22, the method of claim 20 is as above-disclosed.

Claim 21. Hidary further discloses a server connected to ride area network, said server capable of receiving said identity and physical location Information to create said user file. (fig 2 item 24 and associated text)

Claim 22. Hidary discloses step (c) is carried out using information transmitted by said electronic device when connected to said network (see abstract, whole document, and above discussion).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 3-4, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary as applied to claims 1-2 (for claims 3-4) and 11 (for claims 12-13) above, and further in view of Titmuss, WO 97/37500, hereinafter Titmuss.**

As for claim 3, the method of claim 2 is as above-disclosed.

Hidary does not disclose the step (b) of determining the location of said electronic device is accomplished using a global positioning satellite which provides global coordinate information

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of said electronic device when connected to said wide area network. However GPS enabled cell phones based on which the device/user location is tracked, are disclosed by Titmuss (abstract, see p. 8 l. 15 et seq.). One skilled in the marketing arts would have known to combine the teachings of Titmuss to Hidary's to provide another way of locating (to ensure reaching) a potential consumer. (Thus Titmuss discloses that user location can be tracked by many ways :see p. 8 l. 26 et seq.)

Claim 4. . Hidary does not disclose step (b) is carried out by a wireless modem connected to said electronic device and a cellular telephone system capable of determining the physical location of said wireless modem used to connect said electronic device to said wireless network. However, Titmuss discloses PDA's and other electronic devices adapted to communicate via cellular networks using dedicated modems.(see p. 1). Further Titmuss discloses a method of sending a signal to an user using the signal format compatible with the receiving device. (see abstract, and generally the whole document) Thus, one skilled in the marketing arts would have known to combine the teachings of Titmuss to Hidary's to provide the capability of reaching ever-more mobile customers doted with different types of devices. The motivation/ need for system flexibility is taught by Titmuss (abstract).

As for claims 12-13, the method of claim 11 is as above-disclosed.

Claim 12. Hidary does not but Titmuss does disclose the step (c) of determining the physical location of said electronic device is accomplished using a global positioning satellite system which provides global coordinate information of said electronic device. (The additional limitation of this claim 12 parallels that of claim 3 and is disclosed as above (see claim 3))

As for claim 13, the method of claim 12 is as above-disclosed. Further Hidary discloses step (d) is carried out using information transmitted by said electronic device when connected to said network. (based on the user ID received the ads are selected by profiling the Hidary user ; see whole document)

5. Claims 7 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary as applied to claims 6 (for claim 7) and 15 (for claims 16-17) above, and further in view of Pepe et al, US 5673322, hereinafter "Pepe", and Roth, WO 98/34189, hereinafter 'Roth'.

As for claim 7, the method of claim 6 is as above-disclosed.

Claim 7. Hidary does not disclose the step of determining the network connection activities of said electronic device is carried out by determining the existence of "cookies" on said electronic device. However, by 1997, wireless electronic devices capable of Internet connections are known (see, e.g., Pepe et al, US 5673322). Further, Roth, WO 98/34189, discloses targeting of ads based on user activities when connected to the Internet is old (see p. 1 and 2). Roth further discloses the use of cookies for such targeting. (Fig 1 item 11 and 11a and related text). Thus one skilled in the arts would have known to combine Roth's targeting by cookies teachings to that of Hidary's to extend the extensive power of the Internet to better service the mobile user once wireless Internet devices technology becomes available.

As for claims 16-17, the method of claim 15 is as above-disclosed.

Claims 16 and 17 appear to address Internet connections. Thus Roth and Pepe in view of Hidary, disclose such method as discussed in claim 7. Further Official Notice is taken that the steps of identifying electronic devices when connecting to the Internet by determining the numerical address assigned to said electronic device by said server (claim 16) or by using client software (such as AOL) to transmit identification information (claim 17) are old. Thus one skilled in the arts at invention time, would have known to use such known techniques to ID a user/device for more efficient ads delivery as taught by Hidary (Note: Hidary teaches several ways to ID a user/device).

Conclusion

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6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roth , WO 98/34189, (august 1998) discloses Internet advertising bidding system whereby the viewers characteristics, are transmitted and targeted ads are delivered . This reference can be used to reject claims 5-7, 13-19.

Griffith, US 5812953, discloses cell phone ID tracking through the MTSO network (cols. 1 and 2)

Malackowski et al, US 5752186 (5/98) discloses wireless ID of user by access code

Park WO 96/04633, discloses targeted advertising to GPS tracking vehicle

Park WO 97/17774,, discloses selective advertising to GPS tracked vehicle

Mannings et al , WO 96/07110, discloses GPS based mobile navigation system based on user requests.

Obradovich et al, US 6133853 teaches a personal communication device with GPS determined user location and supply of information on user requests

Tracy et al, 5979757, discloses wireless shopping device based on consumer activities. This ref. could be used to reject most claims.

Pepe et al, US 5673322, discloses connection of wireless devices to Internet

Hidary, US 5852775 discloses cellular phone advertising system w/ MTSO, cell ID, subscriber profiles, targeted messages

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*Smith, US 5717374, discloses method for sending ads to vehicles while coupled to gas filling stations

* submitted by the Applicants as prior art

Bouve et al , US Pat 5682525 teaches a method for obtaining information on a mobile computing environment with the step of providing a list of merchants proximal to the mobile computing environment using GPS receiver

Heron , US 6055478, teaches an integrated vehicle navigation, communication and entertainment system with Internet access.

Behr et al, US 5543789, discloses remote navigation system with queries and responses

Titmuss et al, WO 98/47295 , discloses a method for guiding a shopper on a mobile computing environment

Titmuss et al, WO 97/37500 , discloses a method for sending a format-compatible signal to an electronic device nearest the user upon tracking the user. This ref in view of Hidary could be used to reject most claims.


Angles et al, US 5933811, discloses delivery of customized ads through Internet

Blinn et al., US 5999914, discloses Internet e-promotions by monitoring user activities.

A.E. Fano, Proceedings of the International Conference on Autonomous Agents, ACMAs for Shopper's Eye: using location-based filtering for a shopping agent in the physical world, by claim 15, "interfa, NY, Ny, USA p. 416-421, conference date 05/09-13/1998. This article could be used in view of Hidary to reject some claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner can normally be reached on Monday-Friday from 9:00 AM - 5:30 PM. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. Facsimile transmissions to this Group may be directed to (703) 305-3718. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


May 21, 2001



ERIC W. STAMBER
PRIMARY EXAMINER